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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,206	04/20/2001	Kazuyuki Yoshida	Q64192	9382

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037

EXAMINER

UNGAR, DANIEL M

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/838,206	Applicant(s) YOSHIDA ET AL.	
	Examiner Daniel M. Ungar	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14, 15, 17-26, 29, 30, 32, 33, 35, 36, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 15, 17-26, 29, 30, 32, 33, 35, 36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED OFFICE ACTION

1. Claims 1-11, 14-15, 17-26, 29-30, 32-33, 35-36, and 38-39 have been examined.

CLAIM REJECTIONS - 35 U.S.C. 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11, 14-15, 17-26, 29-30, 32-33, 35-36, and 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All claims not treated in the following rejections are rejected for indefiniteness due to their dependency on other rejected claims.

4. Regarding claims 1, 14, 17, 29, 32, 35, and 38, it is unclear how a substituting device is used for generating. Further, when the claim states, "substituting the generated substitute information *for* part of the recording information," it is unclear which of the "generated substitute information" and the "recording information" is prior to the substitution and which is after.

5. Similarly in claims 2, 14, 15, 18, 30, 33, 36, and 39, it is unclear which of the "generated substitute information" and the "generated encrypted recording information" is prior to the substitution and which is after.

6. Claim 10 recites, "to use *it*", which is indefinite.

7. Claim 15 recites the limitations "the information recording region", "the encrypted recording information", "the encryption", and "the predetermined key information", which lack sufficient antecedent basis.

CLAIM REJECTIONS - 35 U.S.C. 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Regarding claims 1, 29, and 35, Matyas et al. disclose an information recording device, medium, and method comprising generating substitute information by using identification information unique to a recording medium and recording the generated substituted information in the medium corresponding to the identification information (see column 5, lines 30-50; column 9, lines 42-53; figure 10).

10. Regarding claims 2, 30, and 36, Matyas et al. disclose encrypting the recording information, generating the substitute information, and recording the key information and the generated substituted recording information in the medium (see abstract; column 4, line 58 – column 5, line 7; column 6, line 59-65; figures 2-4).

11. Regarding claim 3, Matyas et al. disclose generating the substitute information including the key information (see column 9, lines 42-53).

12. Regarding claims 4-6, Matyas et al. disclose encrypting the key information by using the identification information to generate encrypted key information, and performing a predetermined encrypting process to generate encrypted identification information (see column 6, lines 44-65; figure 3, items 26-30).

13. Regarding claim 7, Matyas et al. disclose an encrypting process that uses a predetermined unidirectional encrypting function (see column 11, lines 26-64; column 12, lines 17-27). Note that the public key encryption system inherently includes a unidirectional encrypting function.

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14. Regarding claims 9, Matyas et al. disclose recording identification information (see column 5, lines 30-50; column 7, lines 45-48; figure 2).
15. Regarding claim 10, Matyas et al. disclose the identification information recorded in advance (see column 12, lines 54-64), and the substitute information generating device detects the recorded identification information to use it for the generation of the substitute information (see column 6, lines 20-22; figure 3).
16. Regarding claim 11, Matyas et al. disclose varying a mode of substitution by using the identification information (see column 6, lines 44-58; figure 3).
17. Regarding claim 14, Matyas et al. disclose an information recording medium comprising an information recording region obtained by substituting information generated using unique identification information for part of recording information, and an identification information recording region (see column 5, lines 30-50; column 9, lines 42-53; figures 2, 3, and 10).
18. Regarding claim 15, Matyas et al. disclose encryption of the recording information by using predetermined key information (see column 6, lines 44-65; figure 3, items 26-30).
19. Regarding claims 17, 32, and 38, Matyas et al. disclose a reproducing method comprising detecting the substituted recording information and identification information, and extracting the substitute information and identification information (see column 7, line 67 – column 8, line 16; column 9, lines 4-22; figures 8 and 9), comparing the identification information extracted from the substitute information with the detected identification information (column 9, lines 23-41); and reproducing the recording information only if the extracted identification matches the detected information (see column 11, line 65 – column 12, line 16).

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20. Regarding claims 18, 33, and 39, Matyas et al. disclose encryption of the recording information using a predetermined key information (see column 6, lines 44-65; figure 3); the key information and the obtained substituted recording information are recorded in the information recording medium (column 4, line 58 - column 5, line 7; column 6, lines 44-65; figure 3); detecting the key information (see column 7, line 67 - column 8, line 16; column 9, lines 4-22; figures 8 and 9); and decrypting the encrypted recording information obtained from the detected substituted recording information only if the extracted identification matches the detected information (see column 11, line 65 - column 12, line 16).

21. Regarding claim 19, Matyas et al. disclose the key information contained in the substitute information and recorded in the medium, and detected from the extracted substitute information (see column 9, lines 42-53; column 9, lines 4-22).

22. Regarding claim 20, Matyas et al. disclose encrypting the key information by using the identification information, and recording the encrypted key information in the medium (see column 6, lines 44-65; figure 3, items 26-30); detecting the encrypted key information from the medium, and generating the key information through decryption of the detected encryption key information, and reproducing the record information only if the extracted identification information matches the detected information (see column 7, line 67 - column 8, line 16; column 9, lines 4-22; column 11, line 65 - column 12, line 16; figures 8 and 9).

23. Regarding claim 21, Matyas et al. disclose obtaining the encryption key information by using encrypted identification information from a predetermined encrypting process, and recording the encrypted key information in the medium (see column 6, lines 44-65; figure 3, items 26-30); and decrypting the detected key information by using the encrypted identification information obtained from the encrypting process (column 9, lines 4-22; column 11, line 65 - column 12, line 16).

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24. Regarding claim 22, Matyas et al. disclose the encrypting process using a predetermined unidirectional encrypting function (see column 11, lines 26-64; column 12, lines 17-27). Note that the public key encryption system inherently includes a unidirectional encrypting function.

25. Regarding claims 23 and 24, Matyas et al. disclose generating the substitute information using the encrypted identification information obtained by the predetermined unidirectional encrypting process to the identification information (see abstract; column 4, line 58 – column 5, line 7; column 6, line 59-65; column 11, lines 26-64; column 12, lines 17-27; figures 2-4); extracting the encrypted identification information from the extracted substitute information, and decrypting the information by a corresponding decrypting process, and reproducing the record information only if the generated identification information matches the detected information (see column 7, line 67 – column 8, line 16; column 9, lines 4-22; column 11, line 65 – column 12, line 16; figures 8 and 9).

26. Regarding claim 26, Matyas et al. disclose varying a mode of substitution by using the identification information, and extracting the substitute information the detected substituted recording information based on the mode of substitution (see column 6, lines 44-58; figure 3).

CLAIM REJECTIONS - 35 U.S.C. 103(a)

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas et al., as established above, in view of Weiss, U.S. Patent Number 4,654,480.

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Matyas et al. fail to add a device for error correction, wherein the substituting device substitutes the generated substitute information for part of the added record information to generate the substituted recording information. Nevertheless, correcting for errors during an encryption process was well known in the art at the time of the invention. Exemplary of this is Weiss who, in a similar field of endeavor, discloses error correction as part of the encryption process to generate the substituted recording information (see abstract; column 10, lines 6-26). In light of the teachings of Weiss, it would have been an obvious addition to the system of Matyas et al. to correct for error while encrypting.

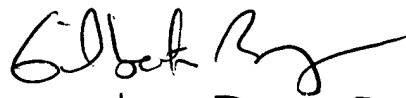
CONCLUSION

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M. Ungar whose telephone number is 571.272.7960. The examiner can normally be reached on 8:30 - 6:00 Monday - Thursday, Alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571.272.3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel M. Ungar


Gilberto Barron Jr
SPE 2132